

Cigelske, James J. Jr.

U.S. Serial No. 10/065,774

TRAVERSAL REMARKS

In the Office Action mailed November 7 2003, the Examiner set forth, once again, a three-way restriction of claims 1-20. As noted above, Applicant has elected claims 1-8 and 15-20 of Group I. The Examiner originally set forth a three-way restriction of claim 1-20 in an Office Action mailed June 16, 2003. In the Office Action mailed October 7, 2003, the Examiner withdrew the restriction previously set forth on June 16, 2003. While Applicant appreciates the Examiner's withdrawal of the original restriction requirement, Applicant does not believe that a renewed restriction requirement was warranted. Specifically, Applicant believes the restriction of claims 1-20 to be improper in light of the similarities between that which is called for in each claim group.

The Examiner identified claims 1-8 and 15-20 as being drawn to a portable welding apparatus and classified the claims in class 361, subclass 212. Claims 9-11 were identified as being drawn to a shield and classified in class 174, subclass 35r. The Examiner identified claims 12-14 as being drawn to a method of providing electrical shielding apparatus and classified the claims in class 29, subclass 592.1.

With respect to the restriction of Groups I and II, the Examiner indicated that inventions I and II are related as combination and subcombination. Specifically, the Examiner asserts that, "[T]n the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as the apparatus does not require the shield being inverted U-shaped." The Examiner adds, "[T]he subcombination has separate utility such as the shield can be used with other electrical devices." Applicant disagrees that these distinctions warrant restriction.

MPEP §806.05(c) provides that restriction is proper "[w]here a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search" (emphasis added). MPEP §806.05(c). Reasons for insisting upon restriction may be shown by a separate classification thereof, a separate status in the art when they are classifiable together, and a different field of search. MPEP §808.02.

MPEP §808.02 provides that the Examiner may establish a reason for insisting on restriction based on a separate classification of the inventions. That is, the Examiner may show "that each distinct subject has attained recognition in the art as a separate subject for inventive

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effort, and also a separate field of search" (emphasis added). Id. Therefore, in the present application, the Examiner is relying on the separate classification of the inventions to suggest that separate searches are required.

Applicant believes that a search of one group of claims would necessarily include a search of the other claim groups. That is, a search of claims 1-8 and 15-20 would necessarily include a search of that called for in claims 5-7 as well as claim 16. Claims 5-7 further define the electrical shield of claim 1 as having a generally U-shaped configuration. Claim 16 further defines the at least three planar sides of the non-conductive shield as having a generally U-shaped configuration. Similarly, claim 9 of Group II positively calls for a U-shaped configuration for the shield. Therefore, a search of claims 1-8 and 15-20 would necessarily include a search of the invention of claims 9-11. As such, the search of claim 1-8 and 15-20 would be coextensive of the search for claims 9-11. Notwithstanding distinctness between the inventions and separate classification afforded by the Examiner, a separate search of each group is not required and, as such, the Examiner has not provided sufficient reasons for insisting upon restriction. Accordingly, claims 1-8 and 15-20 should be rejoined with claims 9-11 for examination in the present case.

Further, claim 13 of Group III further defines the electrical shield of claim 12 as having a generally U-shaped configuration. As such, a search of claims 1-8 and 15-20 of Group I would necessarily include a search of that called for in claim 13 of Group II. As such, Applicant believes that claims 12-14 should be rejoined with claims 1-8 and 15-20 of Group I and claims 9-11 of Group II for examination in the present application.

The Examiner further restricted Group I, claims 1-8 and 15-20, and Group III, claims 12-14, as process of making and product made under MPEP §806.05(f). A product "can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process." MPEP §806.05(f).

The Examiner stated that "[i]n the instant case the apparatus does not require the internal surface having a plurality of ribs." Both Group I and Group III call for, in part, a plurality of ribs extending outwardly from the end panel. In particular, claim 18 of Group I calls for "the portable welding apparatus of claim 15 wherein the end panel has a plurality of ribs extending outwardly proximate the electrical stud and the non-conductive shield is affixed to the end panel by being interfitted within the ribs." Claim 12 of Group III calls for, in part:

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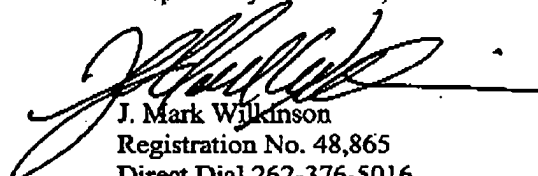
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providing a portable welding apparatus comprising a conductive enclosure having an end panel, the end panel having an external surface and an internal surface to form an enclosed space with the conductive enclosure to contain conductive components, the end panel having an electrical terminal having a receptacle on the external surface and an electrical stud on the internal surface, the internal surface having a plurality of ribs extending outwardly therefrom. (emphasis added)

The apparatus of Group I, therefore, is not "made by another and materially different process" as claimed in Group III. Further, a search of claims 12-14 with respect to the "ribs" called for in claim 12, would necessarily include a search of the inventions of claims 1-8 and 15-20. That is, claim 4 and claim 18 of Group I each call for a plurality of ribs. As such, Applicant believes that the restriction of Groups I and III is improper. Applicant requests that Groups I and III be rejoined and that the restriction be withdrawn.

Therefore, in light of at least the foregoing, Applicant believes that claims 1-20 should be rejoined for examination and consideration in the present application. The Examiner is invited to call the undersigned to discuss this Restriction Requirement or any other matters regarding this application.

Respectfully submitted,



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